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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,584	03/10/2000	Toyoaki Furusawa	0828.63692	5350

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Patrick G. Burns Esq.
Greer Burns & Crain Ltd.
300 S. Wacker Dr.
Suite 2500
Chicago, IL 60606

EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,584

Applicant(s)

FURUSAWA ET AL.

Examiner

DAVID Y. ENG

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim 3 has been cancelled. The active claims are 1-2 and 4-7.

Applicants are requested to identify the teaching of examining the **body** of the email message for keywords in the specification under 37CFR1.75d1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls (USP 6,662,232) in view of Milsolavsky (USP 6,732,156).

Nicholls teaches a message processing apparatus for receiving and displaying e-mail messages (see the first 2 lines of abstract) sent from a sending end to a receiving end, the email messages having at least a header, a title and a body (well known), the apparatus comprising:

Reception means (line 7-10, abstract) for receiving an e-mail message sent from the sending end;

A keyword lookup table (the collection of keywords programmed by the user, such as keyword "Allport" appearing in the user identification, domain name "PBltid" or "top priority", etc.) (see column 5, line 7-13) that associates predefined keywords with handler programs (see "enhancement features" in line 6 of column 5 and "priority messaging tasks" in Figure 7 and in line 19 of column 5 and in lines 13-43 of column 6), the keywords representing a characteristic of the e-mail messages, such as worthiness or urgency (see "priority features" in line 5 of column 5),

Keyword information extraction means (the circuit in Nicholls for identifying keywords such as "allport" etc. in e-mail messages, see lines 13-43 of column 6) for examining the title or body (key words can be in any section of the e-mail message in Nicholls) of the e-mail message received by said reception means with reference to said keyword lookup table to determine whether the received e-mail message contains any one of the keywords defined in the keyword lookup table;

Program loading means (see "priority messaging tasks" in line 32-33 of column 6), disposed at the receiving end, for consulting said keyword table to load one of handler programs (fax, paged or telephone, see Figure 7) that is associated with the keyword found in the received e-mail message; and

Executing means (processor, disposed at the receiving end, for executing the handler program loaded by said loading means at prescribed times.

Nicholis teaches extraction of keyword from header or title but not body of email messages. Searching and extracting keywords from body of a email message is well known in the art. Milsolavsky teaches a message processing apparatus (see abstract) for receiving and displaying email messages. Milsolavsky further teaches in lines 52-59 of column 4 extracting of keywords from the body of email messages. From the teaching of Milsolavsky, it would have been obvious to a person of ordinary skill in the art to search the email body in Nicholes such that proper actions can be taken in response to the search of keywords.

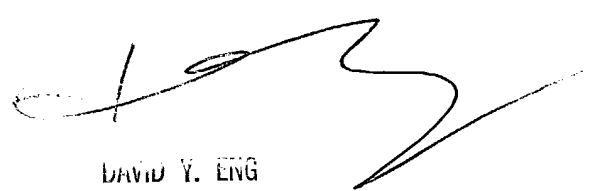
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Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls (USP 6,662,232) and Milsolavsky (USP 6,732,156) further in view of Fujiwara (USP 6,301,710).

Nicholls and Milsolavsky teach claim combination set forth above. Downloader is well known in the art. See the abstract in Fujiwara. Whether programs are pre-stored or downloaded is a matter of design choice. From the teaching of Fujiwara, it would have been obvious to a person of ordinary skill in the art to use a downloader to download the programs of Nicholis to subscribers such that the subscribers can used the subscribed features.

In the communication filed on 8/3/2004, Applicants argued that Nicholes seaches the header or tile of email for keywords but not the body of the messages. However, Applicants failed to explain why it is a **patentable** distinct feature.

Any inquiry concerning this communication should be directed to DAVID Y. ENG at telephone number 703-305-9691.



DAVID Y. ENG
PRIMARY EXAMINER